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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,570	06/27/2003	Akira Kikitsu	008312-0304515	4947
909	7590	06/09/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			BERNATZ, KEVIN M	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

1773

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,570

Applicant(s)

KIKITSU ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 30 and 32, drawn to a magnetic recording medium and a nominal recording and reproducing apparatus, classified in class 428, subclass 694TM+.
 - II. Claim 31, drawn to a non-nominal magnetic recording/reproducing apparatus, classified in class 360, subclass 55+.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the recording/reproducing apparatus can be used with any type of recording medium. The subcombination has separate utility such as being used in a magnetic recording/reproducing apparatus without a separate auxiliary head.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Should applicants elect group I, this group contains claims directed to the following 55 patentably distinct species of the claimed invention: a recording medium structure comprising a first magnetic recording layer, at least one intermediate layer M1 – M7, and a second magnetic recording layer, wherein the orientation of the recording layers are either parallel or perpendicular to the plane of the layers. The 55 distinct species, from which applicant must elect a single specie to be examined, are the following:

Specie Number	Orientation of Recording Layers	Interlayer Structure
1	Perpendicular	M1
2	Perpendicular	M2/M1
3	Perpendicular	M4/M2/M1
4	Perpendicular	M2/M1/M3
5	Perpendicular	M4/M2/M1/M3
6	Perpendicular	M2/M1/M3/M5
7	Perpendicular	M4/M2/M1/M3/M5
8	Perpendicular	M1/M3
9	Perpendicular	M1/M3/M5
10	Perpendicular	M6/M4/M1
11	Perpendicular	M6/M4/M1/M3
12	Perpendicular	M6/M4/M1/M5
13	Perpendicular	M6/M4/M1/M3/M5

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14	Perpendicular	M6/M4/M1/M5/M7
15	Perpendicular	M6/M4/M1/M3/M5/M7
16	Perpendicular	M6/M4/M2/M1
17	Perpendicular	M6/M4/M2/M1/M3
18	Perpendicular	M6/M4/M2/M1/M5
19	Perpendicular	M6/M4/M2/M1/M3/M5
20	Perpendicular	M6/M4/M2/M1/M5/M7
21	Perpendicular	M6/M4/M2/M1/M3/M5/M7
22	Perpendicular	M1/M5/M7
23	Perpendicular	M2/M1/M5/M7
24	Perpendicular	M4/M1/M5/M7
25	Perpendicular	M4/M2/M1/M5/M7
26	Perpendicular	M1/M3/M5/M7
27	Perpendicular	M2/M1/M3/M5/M7
28	Perpendicular	M4/M1/M3/M5/M7
29	Perpendicular	M4/M2/M1/M3/M5/M7
30	Parallel	M4/M2/M1
31	Parallel	M6/M4/M2/M1
32	Parallel	M4/M2/M1/M3
33	Parallel	M6/M4/M2/M1/M3
34	Parallel	M2/M1/M3/M5

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35	Parallel	M4/M2/M1/M3/M5
36	Parallel	M6/M4/M2/M1/M3/M5
37	Parallel	M2/M1/M3/M5/M7
38	Parallel	M4/M2/M1/M3/M5/M7
39	Parallel	M6/M4/M2/M1/M3/M5/M7
40	Parallel	M1/M3/M5
41	Parallel	M1/M3/M5/M7
42	Parallel	M6/M4/M1
43	Parallel	M6/M4/M1/M3
44	Parallel	M6/M4/M1/M5
45	Parallel	M6/M4/M1/M5/M7
46	Parallel	M6/M4/M1/M3/M5
47	Parallel	M6/M4/M1/M3/M5/M7
48	Parallel	M6/M4/M2/M1/M5
49	Parallel	M6/M4/M2/M1/M5/M7
50	Parallel	M1/M5/M7
51	Parallel	M2/M1/M5/M7
52	Parallel	M4/M1/M5/M7
53	Parallel	M4/M2/M1/M5/M7
54	Parallel	M4/M1/M3/M5/M7
55	Parallel	M4/M2/M1/M3/M5/M7

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 – 6, 27 and 30 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. No telephone call was made to applicants due to the complexity of the restriction requirement. Applicant is advised that the reply to this requirement to be complete must

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include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

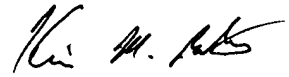
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
June 7, 2005


Kevin M. Bernatz, PhD
Primary Examiner